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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/189,410	11/10/98	KURIKI	M 826.1517/JDH
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EXAMINER

CALDWELL, A

ART UNIT

PAPER NUMBER

2154

DATE MAILED:

01/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/189,410

Applicant(s)
Kuriki et al.

Examiner
Andrew Caldwell

Group Art Unit
2154

☒ Responsive to communication(s) filed on Nov 10, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-27 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-27 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

Remarks

1. Claims 1-27 are presented for examination.
2. Although the claims meet the requirements of 35 U.S.C. 112 2d (i.e., the metes and bounds are determinable), the grammar and syntax of the claims could be improved. For example: claim 2 line 3 - "that receiver"; claim 3 line 2 - "wherein content"; claim 5 line 5 - "that receiver". These are merely examples. All of the claims could be edited to conform with proper English grammar. In addition, claim 10 does not include a transition phrase. It is in the best interest of the patent community that the Applicants consider these editorial suggestions when preparing a response to this Office action.

Specification

3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Tsuji '898

5. Claims 1-2, 4-12, 18, 21-22, and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsuji et al., U.S. Patent No. 5,764,898.

Claims 1-2 and 4-12:

6. Regarding claim 1, Tsuji anticipates the claimed invention by teaching a system comprising:

a. Preparation means for preparing a receiver state list indicating states of a plurality of receivers of a message whose destinations are the plurality of receivers (Fig. 1 elem. 37 task tracking unit as preparation means; Fig. 4 elem. 45 receiver state list; Col. 5 lines 26-47);

b. Management means for managing information in the receiver state list (Fig. 1 elems. 31, 33, 24, 38, 23, and 32; Col. 3 line 64 to Col. 4 line 35).

7. Regarding claim 2, Tsuji teaches a system wherein the receiver state list includes completion information indicating that receiver confirms the message, or a business related to the message is completed (Fig. 4 elem. 45; Col. 5 lines 26-47).

8. Regarding claim 4, Tsuji teaches a system wherein the receiver state list includes open information indicating open states of the message of the plurality of receivers, and completion information indicating that the message is confirmed, or that business related to the message is completed (Col. 4 line 59 to Col. 5 line 9; indication of mail not yet processed as "open information"; return, accept, copy, and commentate as control information).

9. Regarding claim 5, Tsuji teaches a system comprising:

a. Storage means for storing content of the message, receivers' names, and completion information indicating that receiver confirms content of the message, or that business related to the message is completed, corresponding to each other (Col. 4 lines 10-42 control information memory unit, received mail memory unit, and sent mail memory unit);

b. Wherein the preparation means prepares the receiver state list based on the receivers' names and the completion information (Col. 5 lines 26-47).

10. Regarding claim 6, Tsuji teaches a system comprising:

a. Amendment means for amending contents of transmitted message stored in the storage means (Col. 4 line 59 to Col. 5 line 9 commentate processing; Col. 5 lines 26-47);

b. Recovery means for recovering all the receivers' open information indicating whether or not the receiver opens the message from an opened state to a not-opened state when the message is amended by the amendment means (Col. 4 line 59 to Col. 5 line 9; Col. 5 lines 26-47).

11. Regarding claim 7, Tsuji teaches a system wherein the storage means stores comments prepared by the receivers for the message and the recovery means makes the comments stored in the storage means be stored as they are, when the transmitted message is amended by the amendment means (Col. 4 line 59 to Col. 5 line 9 commentate processing).

12. Regarding claim 8, Tsuji teaches a system wherein:

a. The storage means stores message type of the message (Col. 4 line 59 to Col. 5 line 9; Col. 5 lines 26-47);

b. The preparation means prepares the receiver state list according to the message type, the receivers' names, and the completion information (Col. 4 line 59 to Col. 5 line 9; Col. 5 lines 26-47).

13. Regarding claim 9, Tsuji teaches a system:

a. Further comprising set means for displaying comment alternatives of comment pattern which correspond to the message

type of the received message, in comment section of the received message, and for setting comment pattern which corresponds to comment alternative selected by receiver as the receivers' comment to the received message (Col. 4 line 59 to Col. 5 line 9 commentate processing; Col. 5 lines 26-47);

b. Wherein the storage means includes a comment pattern in the storage portion for storing, corresponding to the message type, the comment pattern and the comment alternatives which correspond to the comment pattern (Col. 4 line 59 to Col. 5 line 9; Col. 5 lines 26-47).

14. Regarding claim 10, Tsuji teaches a system for enabling a sender and all receivers of the message to confirm content of the message and the receiver state list on screens of terminals (Col. 3 lines 7-10 and 64-66).

15. Regarding claim 11, Tsuji teaches a system wherein a comment section for inputting comment to received message is provided in the message, and comment inputted to the comment section is displayed as comment of respective receiver, in the receiver state list (Col. 4 line 59 to Col. 5 line 9 commentate processing).

16. Regarding claim 12, Tsuji teaches a system wherein delay state regarding response time limit which is set in the message is displayed as delay information in a received message list (Col. 5 lines 10-25 deadline processing).

Claim 18:

17. Regarding claim 18, Tsuji anticipates the claimed invention by teaching a method comprising:

a. Preparing a receiver state list indicating states of a plurality of receivers of a message whose destinations are the plurality of receivers (Fig. 1 elem. 37 task tracking unit as preparation means; Fig. 4 elem. 45 receiver state list; Col. 5 lines 26-47);

b. Displaying the receiver state list on a terminal (Fig. 4 elem. 45; Col. 5 lines 26-47).

Claims 21-22:

18. Regarding claims 21-22, they are method claims corresponding to apparatus claims 1-2. Since they do not teach or define above the information in the corresponding apparatus claims, they are rejected under the same basis.

Claim 24:

19. Regarding claim 24, Tsuji teaches a computer readable storage medium storing a program comprising the steps of displaying a receiver state list which includes receivers' names of message and completion information indicating that content of the message is confirmed, or that business related to the message is completed, on a terminal (Fig. 4 elem. 45; Col. 5 lines 26-47).

Claims 25-27:

20. Regarding claims 25-27, they are computer readable media claims corresponding to apparatus claims 1-2 and 4. Since they do not teach or define above the information in the corresponding apparatus claims, they are rejected under the same basis. The corresponding claims are: 25 with 1, 26 with 2, and 27 with 4.

Ouchi '836

21. Claims 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Ouchi, U.S. Patent No. 5,978,836.

Claims 16-17:

22. Regarding claim 16, Ouchi anticipates the claimed invention by teaching a system comprising:

a. Preparation means for preparing a message list of displaying a formatted message type message related to a process of business and a non-formatted type message related to a process other than business, together with a message type (Col. 5 lines 23-37 showing email user receiving workflow message in inbox; Col. 19 lines 43-46 showing display of both workflow and nonworkflow email; Col. 19 lines 49-52 email priorities as message types);

b. Message management means for managing information in the message list (Col. 4 lines 38-35 email client).

23. Regarding claim 17, it is an method claim corresponding to apparatus claim 18. Since it does not teach or define above the

information in the corresponding apparatus claim, it is rejected under the same basis.

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

25. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Tsuji '898

26. Claims 3, 15, 19-20, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuji.

Claims 3 and 15:

27. Regarding claim 3, Tsuji teaches the invention substantially as claimed. See the rejection of claim 2 above. Tsuji teaches a system wherein the sender stores sent messages (Col. 4 lines 21-41). Based on this fact, a person of ordinary skill in the art

at the time the invention was made would reasonably conclude that the system of Tsuji implicitly teaches a system in which the sender can display workflow and email messages that were already sent. Tsuji also teaches a system in which the receiver state list is displayed (Fig. 4; Col. 5 lines 26-47 status report display). The message content and the receiver state list are inherently linked, or associated with one another, because the receiver state list is derived from information stored in the sent mail memory unit (Col. 4 lines 43-47). Tsuji therefore teaches a system in which the content of the message and the receiver state list are displayed on a terminal, and in which the content of the message and the receiver state list are linked with each other. Please note that the claim language does not require the receiver state list and the message content to be simultaneously displayed on the terminal.

28. Regarding claim 15, Tsuji teaches the invention substantially as claimed. See the rejection of claim 1 above. Tsuji does not teach the additional limitations of claim 15. Official notice is hereby taken of the fact that keyword searching capability is a known capability of email clients. In such systems, it is possible to search for keywords in different message fields, such as the subject or body. It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to modify the email client portion of Tsuji to include keyword searching capability because this

modification would allow a user to more quickly find a particular message when the user's mailbox(es) contain large numbers of messages.

Claims 19-20:

29. Regarding claim 19-20, they are method claims corresponding to apparatus claim 3-4, respectively. Since they do not teach or define above the information in the corresponding apparatus claims, they are rejected under the same basis.

Claim 23:

30. Regarding claim 23, it is a computer readable media claim corresponding to apparatus claim 3. Since it does not teach or define above the information in the corresponding apparatus claim, it is rejected under the same basis.

Tsuji '898 in view of Williams '733

31. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuji in view of Williams, U.S. Patent No. 5,675,733.

Claim 13-14:

32. Regarding claim 13, Tsuji teaches the invention substantially as claimed. See the rejection of claim 1 above.

33. Tsuji does not teach the additional limitations of claim 13.

34. Williams on the other hand teaches a workflow system that collects and displays statistical information regarding each workflow.system comprising:

a. Open ratio obtaining means for obtaining an open ratio of the message from the open information indicating an open state of the receiver of the message (Col. 1 line 65 to Col. 2 line 22 indicating types of notifications; Col. 5 lines 39-47 indicating that the COD embodiment is merely exemplary of how to implement the other notifications; Col. 10 lines 1-22);

b. Display means for displaying the open ratio of the message in a message list (Col. 11 lines 18-55).

35. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Williams' system for collecting and displaying statistics with the workflow system of Tsuji. This combination would have been obvious because of Williams teaching that its type of display is necessary as the volume of acknowledgment messages becomes large (Col. 2 lines 23-62).

36. Regarding claim 14, it is identical to claim 13 except for the type of "statistics" information collected. Claim 14 is directed to the collection of completion information to generate a completion ration rather than the collection of open information to generate an open ratio as in claim 13. Given this similarity, it is sufficient to point out that Williams teaches that completion information, such as file store, print and delete, can be used to generate statistical displays (Col. 2 lines 10-15).


Conclusion

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Caldwell, whose telephone number is (703) 306-3036. The examiner can normally be reached on M-F from 9:00 a.m. to 5:30 p.m. EST.

If attempts to reach the examiner by phone fail, the examiner's supervisor, Meng-Ai An, can be reached at (703) 305-9678. Additionally, the fax phone for Art Unit 2154 is (703) 308-9051.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 305-9600.

Andrew Caldwell
703-306-3036
January 27, 2001


ZARNI MAUNG
PRIMARY EXAMINER